

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and the reasons that follow. Claims 22-34 were cancelled previously. Claims 18-21, 39-45, and 48-57 were requested to be cancelled in response to a restriction requirement. Claim 1 is amended herein. The amendment is supported at least by paragraph [0002] of the present application. Claims 58-66 are added. The newly added claims do not necessitate a new search as they are similar in scope to pending claims. *Applicant respectfully requests entry of the amendment to put the application in better condition for appeal.*

Claims 1-17, 35-38, 46, 47, and 58-66 are pending in this application.

I. Rejection of Claims 1-17, 36-38, and 46 Under 35 U.S.C. § 103(a)

In section 1 of the Office Action, Claims 1-17, 36-38, and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,990,344 to Dolan *et al.* (Dolan) in view of US Patent Publication No. 2002/0019231 to Palenius *et al.* (Palenius) and further in view of US Patent No. 5,428,816 to Barnett *et al.* (Barnett). Applicant respectfully traverses the rejection.

On page 4 of the Office Action, the Examiner concedes that: “[t]he combination of Doan and Palenius does not explicitly teach that that the ordering of the radio access means are created with a prioritized ordering and selected based on the created prioritized ordering.” For this missing teaching, the Examiner points to Barnett.

In the previous response to office action filed December 3, 2008, Applicant stated:

Palenius describes a first embodiment in which “the terminal receives a measurement command from the access network to which it is presently connected. In the command, the access network orders the terminal to perform measurements on at least one frequency band different from the band in which the terminal presently has connections.” (Para. [0050]). Relative to this embodiment Palenius further states that “the terminal can decide, e.g. in the above selection 32, on which cells in the current frequency band measurements are performed in case of

an urgent handover.” (Para. [0058]). **Thus, according to Palenius, the terminal (mobile station) receives a command and determines an ordering between cells not radio access means.** Therefore, relative to this embodiment, Palenius fails to teach “creating a prioritized ordering of the radio access means,” “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering,” and “sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means” (underlining added) as recited in Claim 1.

(Page 9, Response dated December 3, 2008, underlining in the original, boldface added.)

Thus, Applicant distinguished Palenius because it teaches a mobile station receives a command and determines an ordering between cells not radio access means. Similar to Palenius, Barnett teaches “handoff measurement priority” involving cells not radio access means. In the Abstract, Barnett indicates it describes a “method and system for selecting the best handoff candidate cell.” (emphasis added.) In Barnett, Col. 5, lines 34-62 cited by the Examiner, Barnett describes:

Each neighboring cell has a measurement class and priority associated with a serving cell.

(Col. 5, lines 34-35, emphasis added.)

all the neighboring cells which meet the measurement class criteria are ordered according to their measurement class

(Col. 5, lines 42-44, emphasis added.)

If a suitable neighboring cell meets all criteria for handoff as determined from the CQM, the handoff process for that particular cell is initiated.

(Col. 5, lines 59-62, emphasis added.)

Therefore, Barnett fails to teach “creating a prioritized ordering of the radio access means,” “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering,” and “sending a request to the mobile station to

perform compressed mode measurements at the mobile station based on the selected target radio access means" (underlining added) as recited in Claim 1.

Claim 1, as amended, clearly states that "a radio access means of the plurality of radio access means includes a plurality of cells, and further wherein the plurality of radio access means use different communication systems." Cells, such as those described by Palenius and Barnett, do not "use different communication systems."

On page 3 of the Office Action, the Examiner states:

Regarding claim 1, Dolan teaches a method comprising: ...
wherein the plurality of radio access means use different communication methods (column 3, lines 1-41; first and second cellular networks);
ordering the radio access means based on said information (column 5, lines 38-56);
selecting a target radio access means of the plurality of radio access means based on the ordering (column 6, lines 11-20);

Applicants respectfully disagree. As discussed on pages 7-8 of the previous response filed December 3, 2008, Dolan describes generation of a measurement order list which includes only cells capable of supporting a handoff of the mobile station. Dolan does not teach "creating a prioritized ordering of the radio access means." In Col. 5, lines 30-56, Dolan merely describes excluding the second cellular network because the cells are incapable of supporting a handoff of the mobile station. Dolan further recites:

When the above described method is used for preparing a measurement order list for transmission to the first mobile station MS1 while it is operating in the first cell C1, the control unit 201 determines, at step 501, that the subscriber profile associated with the first mobile station MS1 contains no IMSI and, at step 502, that the set of neighbouring cells C2 C7 includes cells C5 C7 which are incapable of acting as target cells for handoff. Hence, the control unit 201 omits all control channels CC5 CC7 associated with the cells C5 C7 when preparing the measurement order list for transmission to the first mobile station MS1, i.e. the measurement order list contains only the control channels CC1 CC4.

After preparing the measurement order list, the first mobile switching center MSC1 orders the base station BS1 serving the first cell C1 to transmit the measurement order list in a

TIA/EIA IS-136 Measurement Order message MO1 on the digital traffic channel DTC1 to the first mobile station MS1.
The first mobile station MS1 performs measurements in accordance with the measurement order list and reports measurement results by transmitting TIA/EIA IS-136 Channel Quality messages CQ1 on the digital traffic channel DTC1 to the base station BS1 serving the first cell C1.

(Col. 5, line 65-col. 6, line 20; underlining added).

Thus, again, Dolan describes generation of a measurement order list which includes only cells capable of supporting a handoff of the mobile station. Thus, Dolan fails to teach “creating a prioritized ordering of the radio access means.” Dolan also fails to teach “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering.” Dolan selects cells for inclusion in the measurement order list based on the cells capability of supporting a handoff of the mobile station. Dolan does not teach “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering.”

The Examiner agrees that Dolan “does not explicitly teach sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means.” (Pg. 3 Office Action). However, the Examiner states:

Palenius et al. discloses ... the access network commands the terminal to perform measurements for a selected measurement set of cells (page 6, paragraphs 50,55) which may include parameter settings for a compressed mode (performing compressed mode measurements at the mobile station) (page 6, paragraph 51).

(Pp. 3-4 Office Action; underlining added). The Examiner, however, does not indicate that Palenius teaches “sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means” (underlining added) as recited in Claim 1. As discussed above, Palenius teaches a mobile station receives a command and determines an ordering between cells not radio access means.

Therefore, alone and in combination, Dolan, Palenius and Barnett fail to teach, suggest, or describe all of the elements of at least Claim 1. An obviousness rejection cannot be properly maintained where the references do not disclose all of the recited claim elements.

For at least the foregoing reasons, Applicants respectfully request withdrawal of the rejection of Claims 1-17, 36-38, and 46.

II. Rejection of Claims 35 and 47 Under 35 U.S.C. § 103(a)

In section 2 of the Office Action, Claims 35 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dolan in view of Palenius and Barnett and further in view of US Patent No. 5,655,217 to Lemson (Lemson). Applicants respectfully disagree.

As discussed in Section I above, Dolan, Palenius and Barnett fail to teach all of the elements of at least independent Claim 1 from which Claims 35 and 47 depend. Applicants respectfully submit that Lemson also fails to teach all of the elements of at least independent Claim 1.

Lemson describes “a system for allocating one or more ranges of transmission frequency to the communications network, in order to prevent the network from interfering with received signals of an incumbent radio system.” (Abstract). Lemson, however, fails to provide any teaching whatsoever related to “creating a prioritized ordering of the radio access means,” “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering,” and “sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means” as recited in Claim 1. As a result, Applicants respectfully request withdrawal of the rejection of Claim 35 and 47, which depend from Claim 1.

III. New Claims

New Claims 58-66 are patentable for at least the same reasons as those provided above. Applicant respectfully requests entry and allowance of these new claims.

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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